

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT 3764

EXAMINER: Francis Palo
APPELLANT: Donoho, Bruce
SERIAL NO. 09/317,303
FILED: May 24, 1999
FOR: Bird Deterrent
ART UNIT: 3644

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF UNDER 37 CFR § 41.41

This brief responds to the Examiner's Answer, dated November 15, 2007. Please charge any additional fees or credit any overpayment to our deposit account 500341. The Applicant respectfully requests that the appeal filed August 15, 2007 be maintained under 37 CFR 41.41.

This reply brief contains the following items under the headings in the order listed below:

1. Status of claims
2. Grounds of rejection to be reviewed on appeal
3. Argument

I. Status of claims:

1. Claims pending: 10-18 and 20-35;
2. Claims rejected: 10-18 and 20-35; and
4. Claims on appeal: 10-18 and 20-35.

II. Grounds of Rejection to be Reviewed on Appeal:

1. Rejection of claims 10-12, 16-18, 20 and 22-34 under 35 U.S.C. § 103(a) as being unpatentable over Richardson (GB 2344269A), in view of Shaw (US 3,282,000). (Final Office action, page 4).
2. Rejection of claims 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Richardson and Shaw and further in view of Burnside (US 2,777,171) (Final Office action, page 9).
3. Rejection of claims 21 under 35 U.S.C. § 103(a) as being unpatentable over Richardson and Shaw and further in view of Peles (US 2,938,243).
4. Rejection of claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Richardson in view of Burnside.

III. Argument

A. General Remarks

The Applicant maintains his positions as stated in the appeal brief, and all arguments presented therein are incorporated by reference in this paper. Below is the Applicant's response to the arguments presented in the November 15, 2007 opposition brief as follows.

B. The Office Failed To Establish A *Prima Facie* Showing Of Obviousness.

35 U.S.C. 103(a) requires that the patent office support its obviousness rejections with a *prima facie* showing. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). To establish a *prima facie* showing of obviousness three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has the initial burden to show a teaching, motivation, or suggestion to combine. The burden only shifts to the Applicant once the Examiner's burden has been satisfied.

1. Richardson Does Not Provide the Motivation and Suggestion to Include a Fifth Prong.

The Examiner argues that Richardson '269 provides the motivation and suggestion to include a fifth or more prongs because Richardson teaches in the first sentence of the Abstract, "a base element of plastics material molded integrally with a plurality of plastics material prongs extending at at least four different angles to the base element." The Examiner is, however, reading Richardson in a vacuum. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217

F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002)

Richardson only teaches pairs of prongs. (See P4/L14-18; P4/L20-24; P5/L20-24) The exemplary embodiment teaches two pairs of prongs, with each prong extending at a different angle creating “at least four different angles.” A person of ordinary skill in the art (POSITA) with ordinary creativity would read “at least four different angles” to mean that the invention could have additional pairs of prongs, not that a single fifth intermediate prong would be added.

2. The Claimed Combination is Antagonistic to Richardson’s and Shaw’s Goals.

As the Applicant previously informed the Examiner, one of Richardson’s goals is to make stackable devices. (See Richardson P2/L26-33)

“Advantageously the lateral staggering of the first and second pairs of prongs is such that, when viewed in the said direction, the two inner prongs (i.e. one from a first pair and one from a second pair) are angled to one another without mutually overlapping, i.e. without crossing over one another. This assists in nesting of one such bird deterrent device within another *for storage and/or packing and/or transportation*” (italics added)

The Examiner countered with the hypothetical that Richardson “*may* not have been concerned with the stackability of the resulting five-rayed bird deterrent” (emphasis added) despite the fact that Richardson explicitly disclosed that stackability is an advantage of the invention. Theorizing that Richardson “may not have been concerned” with an explicitly defined advantage without any basis in the application is unconvincing.

Additionally, the Examiner failed to consider that Shaw is *also* designed for ease of packaging. (See C1/L43-48)

“the provision of such a bird proofing device which includes separable parts that can be easily coupled together during final installation whereby the device can be *easily handled and packaged* and easily shipped without excessive bulk or danger in handling.” (Italics added)

The present invention can not be easily stacked or packaged without excessive bulk like the inventions of Richardson and Shaw since the intermediate prongs would interfere with one another. The Applicant finds it unlikely that a POSITA would think it obvious to combine Richardson and Shaw into a new invention that is not easily stacked or packaged when both inventions were designed with the goal of creating a bird proofing device that is easily stacked or packaged.

3. There Was No Reasonable Expectation of Success in Combining the Inventions

Even if one were to combine Richardson and Shaw, it was completely non-obvious as of the critical date to combine the references because it was accepted in the art that such a combination was impossible. As evidence, the Applicant submits the declaration from Mr. Wisbacher stating his belief of the skill of one of ordinary skill in the art. Again, the Examiner posits a hypothetical and argues that Mr. Wisbacher was “relying on drawings of the instant invention rather than what is claimed by the applicant.” To support the hypothetical, the Examiner argues that the perception of Mr. Wisbacher as to what applicant claims as his invention is “apparently different” from what the applicant is actually broadly claiming in his invention, but does not provide any actual facts supporting this alleged misperception.

Additionally, the comment of Mr. Wisbacher of the “high cost of developing and producing a tool/mold to accomplish the process limitation” does not contradict the declaration that “one of ordinary skill in the art would have thought that this is/was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by the applicant in his application.” Creating new inventions to accomplish what is perceived as impossible is always associated high research and development costs, and surely does not support the Examiner’s contention that there was a *reasonable* expectation of success.

C. The Examiner Improperly Relies upon *KSR Int’l Co. v. Teleflex Inc.*

1. The Present Claims Recite Something Other Than A Permutation Of Known Alternatives

The Examiner relies on *KSR Int’l Co. v. Teleflex Inc.* for the premise that since Richardson’s and Shaw’s prong configurations were both options known in the art, modifying

Richardson's prong configuration to use Shaw's prong configuration would have been obvious to the ordinary level of creativity used by a POSITA. That, however, is a misreading of *KSR*.

If *KSR* is read to mean that all combinations of known features are obvious, then nothing will ever be patentable. At some level, all inventions are combinations of known things.

What *KSR* says is that where a new combination comprises a set of elements, each of which has a small finite number of known choices, a POSITA would think to try each of those permutations unless dissuaded in some manner. As the Examiner correctly pointed out, the POSITA would try a "simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement." *Ex Parte Smith*, 83 USPQ2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Thus, where an invention involves elements A, B and C, and each one has three known choices, a POSITA would think of all 27 permutations. (A₁B₁C₁, A₂B₁C₁, A₃B₁C₁, A₁B₂C₁, A₂B₂C₁, A₃B₂C₁, A₁B₃C₁, A₂B₃C₁, A₃B₃C₁, etc).

But that isn't what is happening in our case. The present claims are directed to combination of competing choices, prong pairs extending from a single continuous piece, and prong shafts attachable/detachable to a strip. This is a combination of A₁A₂B₁C₁. In our case we have A₁ and A₂, not A₁ or A₂. A combination of competing choices is *not* one of the permutations that would be contemplated by a POSITA under *KSR*.

2. Combining the Inventions of Richardson and Shaw Was Uniquely Challenging and Difficult

Even if *KSR* could be relied on to allow a combination of Richardson and Shaw to create the present invention, evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for a POSITA renders the claim non-obvious. *Ex Parte Smith*, 83, USPQ. 2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Here, the Applicant has submitted the Declaration by Mr. Wisbacher that, at the time of the invention, (1) he would have believed the claimed invention to be impossible to make, (2) he would have been extremely skeptical of the Applicant's chances of success, and (3) he would have thought it would cost a great deal to develop and produce a tool/mold to accomplish such a task. It can be easily inferred from Mr. Wisbacher's declaration that the combination Richardson

and Shaw was uniquely challenging and difficult at the time of the invention, and the Examiner's supposition that Mr. Wisbacher "may" have been thinking of something other than the Applicant's claimed invention is simply not persuasive without some sort of evidence.

D. Peles does not teach the limitation of a cross-shaped cross-section

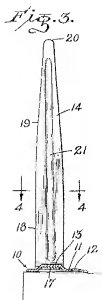
The Examiner cleverly provided a definition of a cross, not from an official treatise or a dictionary, but from an online resource called FactMonster to support the supposition that "a 'T' shape is a known cross-shape as broadly claimed." (See Examiner's Answer P19) The Applicant is not aware of any controlling law from court cases or otherwise that supplants a non-dictionary definition gleaned from an extrinsic source when multiple officially published dictionaries provide definitions that do not support the supposition that a "T shape" is a cross. (See e.g. American Heritage Dictionary, Merriam-Webster's Dictionary)

Additionally, adopting a meaning from extrinsic evidence not allowed when that meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) The last paragraph of page 8 reads:

"As shown in FIGs. 4-7, the cross-section of the prongs where they connect to rail 15 is "T"-shaped as shown in FIG. 5. The cross-section of the prongs along their major length is cross-shaped as shown in FIG. 6 and the cross-section of the prongs close to their pointed ends 16 is circular as shown in FIG. 7."

The language of the specification implies that a T-shape, a cross shape, and a circular shape are all considered discretely different shapes. For the Examiner to then suggest that a T-shape is the same as a cross shape would be antithetical to the words of the specification.

Lastly, the strengthening rib (21) in Peles does not form a T shape. Upon further examination of Figure 3, strengthening rib (21) does not cross or intersect any other element at all.



E. Conclusion

The final rejection in this matter should be reversed. Instruction should be given that the claimed subject matter is allowable over the references cited on the grounds that Richardson and Shaw do not render the claimed invention obvious.

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Respectfully Submitted,

Robert D. Fish
Reg. No. 33880
Agent for Appellant

Fish & Associates, PC
2603 Main Street, Suite 1050
Irvine, CA 92614-6232
tel: 949-253-0944
fax: 949-253-9069
email: mtsang@fishiplaw.com